## REMARKS

Claims 1, 2, 6 - 9, 11 - 20 and 24 - 27 are in the application. Claim 1 is currently amended; claims 1, 2, 7 – 9, 11 – 14, 16, 17, 20, 24, and 25 were previously presented; claims 3 – 5, 10, and 21 – 23 are cancelled; and claims 15, 18, and 19 remain unchanged from the original versions thereof. Claims 1, 16, and 20 are the independent claims herein.

No new matter is added to the application. Reconsideration and further examination are respectfully requested.

**Claim Rejections – 35 USC § 101**

Claims 1, 2, 6 – 9, 11 – 20, and 24 – 27 were rejected under 35 USC 101 for allegedly being directed to non-statutory subject matter. In particular, the Examiner's Answer stated that the rejection was based on a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

The Examiner submitted that the claimed invention does not produce a concrete result. In particular, the Examiner stated that the claimed invention is not repeatable and cannot be implemented without undue experimentation. This rejection is traversed.

Applicant submits that representative independent claim 1 relates to a computer-implemented method for managing risk related to a legal action involving a person, the method including receiving, into a computer memory of a computer, information identifying a person's status as at least one of a party to a legal action and an amicus curiae of the court in a pending legal action; receiving, into the computer memory of the computer, information relating to a plurality of risk assessment factors associated with the legal action, wherein the risk assessment factors are selected from a group

consisting of: a likelihood of prolonged litigation, damages, punitive damages, and damaged public opinion; assigning a numerical value to each of the plurality of risk assessment factors, wherein the numerical value is indicative of a legal risk of each risk assessment factor relative to the other plurality of risk assessment factors; and assigning, by the computer, a weight to each of the plurality of risk assessment factors. The computer-implemented method further includes calculating, by the computer, a plurality of risk factor values by multiplying the numerical value and the weight assigned to each of the plurality of risk assessment factors; calculating, by the computer, a risk quotient for the legal action by summing the plurality of risk factor values; and in response to the calculated risk quotient, generating by the computer, a suggested action associated with the legal action.

Thus, it is clear that the computer-implemented method of claim 1 includes two processes of receiving specifically claimed information *into a computer memory of a computer* and a number of assigning, calculating, and generating processes that are each performed *by a computer*. Accordingly, it is clear that claim 1 is tied to statutory subject matter.

Additionally, Applicant notes that claim 1 specifically claims assigning, by the computer, a numerical value to each of the plurality of risk assessment factors…; assigning, by the computer, a weight to each of the plurality of risk assessment factors; calculating, by the computer, a plurality of risk factor values by multiplying the numerical value and the weight assigned to each of the plurality of risk assessment factors; calculating, by the computer, a risk quotient for the legal action by summing the plurality of risk factor values; and in response to the calculated risk quotient, generating by the computer, a suggested action associated with the legal action. Applicant respectfully submits claimed aspects of receiving information, assigning, calculating, and generating by a computer are in fact repeatable. The claimed computer-implemented method of claim 1 including the particularly recited operations of receiving information, assigning, calculating, and generating *by a computer* also provide a useful, concrete, and tangible

result. Applicant notes that the basis of the rebuttal herein rests with the specific aspects of the pending claims.

In contrast to the repeatable aspects claimed by Applicant, the Examiner's rejection appears to be focused on, for example, "numerical values" that are neither the specifically claimed aspects calculated or generated by the computer nor the result of the computer-implemented method.

Applicant further submits that independent claims 16 and 20 are also directed to statutory subject matter under 35 USC 101 for at least similar to those submitted herein regarding claim 1. Accordingly, Applicant respectfully submits that claims 1, 16, and 20, and the claims depending therefrom, are directed to statutory subject matter under 35 USC 101. Applicant respectfully requests the reconsideration and withdrawal of the rejection of claims 1, 2, 6 – 9, 11 – 20, and 24 – 27 under 35 USC 101.

**Claim Rejections – 35 USC § 112**

Claims 1, 2, 6 - 9, 11 – 20, and 24 - 27 were rejected under 35 U.S.C. 112, 1st paragraph, as failing to comply with the enablement requirement. In particular, the rejected was based on the previous recitation of "consisting of". Applicant notes that claims 1, 16, and 20 are currently amended to replace the previous "consisting of" with "including". Therefore, Applicant submits the claims overcome the rejection thereof under 35 USC 112, 1st paragraph.

Applicant notes that the Examiner's Answer, at page 5, states that the rejection under 35 USC 112, 2nd paragraph was withdrawn.

Therefore, Applicant requests the reconsideration and withdrawal of the rejection under 35 USC 112, 1st and 2nd paragraphs.

**Claim Rejections – 35 USC § 103**

Claims 1, 2, 6 – 9, 11 – 20, and 24 – 27 were rejected under 35 U.S.C. 103(a) as being unpatentable over Heckman et al. U.S. Patent No. 5,875,431 (hereinafter referred to as Heckman).

Applicant respectfully submits that the combination of Heckman and Halligan fail to render Applicant's claims obvious under 35 USC 103(a).

Regarding claims 1, 16, and 20, Heckman was cited and relied upon for disclosing a computer implemented method, system, and program code for managing risk related to a legal action, including a computer system comprising a computer server; receiving, into a computer memory, information relating to a plurality of risk assessment factors associated with legal actions; and generating a suggested action. Halligan was cited and relied upon for disclosing assigning a numerical value to each of a plurality of risk assessment factors, wherein the numerical value is indicative of a legal risk of each risk assessment factor relative to the other plurality of risk assessment factors; assigning a weight to each of the plurality of risk assessment factors; calculating a plurality of risk factor values by multiplying the numerical value and the weight assigned to each of the plurality of risk assessment factors; and calculating a risk quotient for the legal action by summing the plurality of risk factor values.

That is, Heckman discloses a system and method that does not assign numerical values, assign weights, calculate risk factor values by multiplying the numerical value and the weight assigned to the risk assessment factors, and calculate a risk quotient for the legal action by summing the plurality of risk factor values. The entire detailed method and system of Heckman does not include or suggest assigning numerical values, assigning weights, calculating risk assessment factor values by multiplying numerical values and weights, and calculating a risk quotient for the legal action that is analyzed and evaluated by Heckman. In fact, the Heckman process does not rely on or suggest the use of assigned and/or calculated numerical values relating to any of the many types of data used therein.

Halligan however discloses,

In the United States, Section 757 of the First Restatement of Torts set forth six factors for evaluating the existence of a trade secret to assist the courts in adjudicating trade secret cases. One of the inventions we claim is a method of using the six factors to document, weight, and evaluate the existence of a trade secret and measures to protect the trade secret. (emphasis added) (Halligan, paragraph [0009]).

Thus, it is clear that the six factors regarding a trade secret are used to document, weight, and "evaluate the existence of a trade secret and measures to protect the trade secret". The numerical factors disclosed in Halligan, whether assigned or calculated, each relate to the merits of a trade secret and measures to protect (i.e., maintain) the trade secret. While the factors disclosed in Halligan may mirror those used in a court in assessing the existence of a trade secret in a trade secret legal proceeding, the factors themselves are related to the existence (or not) of the trade secret, not a legal action.

Combining Heckman and Halligan as argued by the Examiner would appear to logically result in the legal strategic planning and evaluation system of Heckman regarding a legal proceeding (lacking any assigning and calculating of numerical values) that uses the Halligan disclosed method of documenting, analysis, auditing, accounting, protecting, registering, and verifying of trade secrets. That is, the asserted combination would be a legal analysis system that does not assign or calculate any numerical values to generate a suggested legal action associated with a legal action (disclosed by Heckman) and that uses the trade secret evaluation and analysis method and system to assign numerical values in evaluating trade secrets (as disclosed by Halligan). Even expanding the legal action to those not involving trade secrets (e.g., criminal or malpractice cases), the cited and relied upon combination of references suggest that the evaluation of the underlying subject matter (e.g., criminal or malpractice cases) be evaluated by assigning numerical values as disclosed in Halligan but the overall legal matter be analyzed per Heckman (i.e., no numerical values).

Therefore, it is clear that even if Heckman and Halligan were combined as asserted by the Examiner (not admitted as feasible by Applicant), the combination would not render claims 1, 16, and 20 obvious due to the patentable differences between the claims and the combination of Heckman and Halligan. Accordingly, Applicant respectfully submits that claims 1, 16, and 20 are patentable over Heckman and Halligan under 35 USC 103(a). Furthermore, claims 2, 6 - 9, 11 - 15, 17 - 19, and 24 - 27 depend from claims 1, 16, and 20. It is further submitted that all of the pending claims 1, 2, 6 - 9, 11 - 20, and 24 - 27 are patentable over Heckman and Halligan under 35 USC 103(a).

## CONCLUSION

Accordingly, Applicants respectfully request allowance of the pending claims. If any issues remain, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is kindly invited to contact the undersigned via telephone at (203) 972-5985.

Respectfully submitted,

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Date

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